



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,397	04/11/2000	Hiroshi Satomi	862.C1898	4943

5514 7590 03/01/2004

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

LIANG, GWEN

ART UNIT	PAPER NUMBER
----------	--------------

2172

DATE MAILED: 03/01/2004

31

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/547,397

Applicant(s)

SATOMI ET AL.

Examiner

GWEN LIANG

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 26, 27, 28, 29.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Amendment D, filed on 1/8/04.

This action is made final.

2. Claims 39-44 are pending. Claims 39, 43 and 44 are independent claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 39, 41, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following claimed limitations in the claim are not sufficiently supported in the specification:

Regarding claim 41, the claimed limitation "said second search step is executed when a printing is indicated" is not supported by the applicant's specification. For example, in the specification, page 45 lines 12-14, the disclosure "When a print instruction is received from the P service terminal 100, print data is generated and transmitted to the P service terminal 100." does not support the claimed limitation of search being executed when a printing is indicated.

Regarding claims 39, 43, and 44, the claimed subject matter "inputted code information from a first data base" is not supported by the applicant's specification. The

Art Unit: 2172

examiner cannot find any corresponding description in the applicant's specification and it is not clear to the examiner as to how code information is inputted from a data base.

***Response to Arguments***

5. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 39, 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Skillen et al., "Skillen" (U.S. Patent No. 6,098,065).

With respect to claim 1, Skillen discloses an information providing method ... comprising:

a first search step of searching for a first information corresponding to inputted code information from a first data base; an obtain step of obtaining a first keyword attached to the first information searched for in said first search step and a second keyword associated with a user who inputted the code information via a terminal; a second search step of searching for a second information including the first and second keywords obtained in said obtain step (See for example: col. 1 line 50 - col. 2 line 2,

Art Unit: 2172

"According to a second broad aspect, the invention provides a method of searching for desired information within a data network, comprising the steps of: receiving, from a user, a search request including a search argument corresponding to the desired information; searching, based upon the received search argument and user profile data, a database of information to generate a search result; and providing the search results to the user"; col. 2 lines 33-43 , "Some examples will illustrate how this invention can have high value to an end user. An end user's profile data may contain such information as the make, model and year of automobile he/she owns or leases. When tires are needed, the manufacturers recommended tire types and options may be considered as sort criteria provided within a contextual database. Another example relates to when airline reservations are being sought. All of a person's preferences, which today are normally sorted one by one through a travel agent, could be utilized by the advertising and selling mechanism to provide the informed response."; col. 4 lines 6-7, "Such input search arguments may be received from an end user via the data processing device 12 and data link ..."); and

an output step of outputting the first information searched for in said first search step together with the second information searched for in said second search step (See for example: Abstract "The search results together with the particular advertisement are provided by the machine to the user").

Claim 41 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Skillen discloses a method wherein said second search step is executed ... (See for example: col. 1 lines 65-67).

Art Unit: 2172

Claim 42 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Skillen discloses a method wherein said second search step searches for the second information in consideration of a terminal information of the terminal via which the user inputted the code information (See for example: col. 1 lines 41-45).

Claims 43 and 44 are rejected on grounds corresponding to the reasons given above for claim 39.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen et al., "Skillen" (U.S. Patent No. 6,098,065), and further in view of Morita (U.S. Patent No. 5,297,042).

Claim 40 is rejected for the reasons set forth hereinabove for claim 39. However Skillen does not explicitly disclose a method wherein the first and second keywords have weight values ...

Morita discloses a method wherein the first and second keywords have weight values ... (See for example: col. 1 line 53 – col. 2 line 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide weight values as disclosed by Morita for the first and

Art Unit: 2172

second keywords as disclosed by Skillen in order to provide a document retrieval system which can be constructed with ease (col. 1 lines 50-52).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

ACCIPITER: Accipiter launches adManager 2.0, the most powerful and Management System available: a product that provides advertisers and agencies with targeting functionality including topic, key word phrases, page specific, operating system, browser type, company, and more.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2172


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 703-305-3985. The examiner can normally be reached on 9:00 A.M. - 5:30 P.M. Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

G.L.  
23 February 2004

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER